

III. Nonstatutory Double Patenting Rejection

Claims 49, 67, 69, 71, 73, 75, and 77 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-35 of U.S. Patent No. 6,423,306 B2. Although Applicants disagree with this rejection, they submit herewith a Terminal Disclaimer to render the rejection moot. Accordingly, Applicants respectfully request the withdrawal of this rejection.

IV. Rejection Under 35 U.S.C. § 103

Claims 49, 50, 73, 74, and 77 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,221,534 ("*DesLauriers*") for the reasons set forth on pages 3 - 4 of the present Office Action. Applicants respectfully traverse this rejection.

The Examiner states that it is his position that "since the gels [of *DesLauriers*] are used for make-up and mascara the composition will contain film-forming agents that would add in adhering the polymers to the skin although not mentioned in the prior art." See page 4 of the present Office Action. Thus, according to the Examiner it would have been obvious to one of ordinary skill in the art to use film-forming agents in the formulation of mascara for the purpose of leaving a transfer resistant film layer on the skin. Applicants' respectfully disagree.

The Examiner's assumptions are incorrect. Not all gels used for make-up and mascara contain additional film-forming agents. In fact, not only does *DesLauriers* fail to suggest the use of additional film-forming agents, as admitted by the Examiner,

*DesLauriers* suggests using the gels disclosed therein as “**substitutes** for water-soluble polymers in products such as lip rouge-cream, eyeliner liquid, and the like” and “as a gelling agent in facial oils.” See col. 7, lines 34-37 (emphasis added). Thus, *DesLauriers*, teaching of the use of gels as substitutes does not provide the motivation to use additional film-formers and in fact teaches away from the use of additional film-formers.

This reading of *DesLauriers* is supported by its disclosure that the degree of physical crosslinking exhibited in block copolymers and the gel consistency of the invention are controlled by varying the amount, ratio and **types** of certain polymers, preferably di- and tri-block copolymers. See col. 3, lines 8 - 19. In fact, *DesLauriers* discloses that even the type of solvent or plasticizer to which the blocks are subjected will affect the gel characteristics. See col. 3, lines 43 - 45. Thus, in summary, one of skill in the art would not have had the requisite motivation to add the purposefully balanced compositions of *DesLauriers* to other polymers, let alone film-forming polymers which are known to affect rheological properties. In fact, *DesLauriers* teaches away from such a combination.

With respect to the additional limitation of claim 50, that the composition comprises at least one radial copolymer film former and at least one tri-block copolymer film former, the Examiner is silent. Thus, the obviousness rejection fails on this basis alone per the Federal Circuit’s requirement that “[t]he factual inquiry whether to combine references must be...based on objective evidence of record” and that the Examiner “must also explain the reasoning by which the findings are deemed to support the agency’s conclusion.” See In re Lee, 61 U.S.P.Q.2D (BNA) 1430 (Fed. Cir. 2002).

Moreover, based on the objective evidence of record, one of ordinary skill in would not have had the requisite motivation to select both at least one radial copolymer film former and at least one tri-block copolymer film former. Indeed, *DesLauriers* teaches away from such a selection. *DesLauriers* recites that its compositions comprise a blend of polymers consisting of at least two of: a diblock copolymer, a triblock copolymer, a radial copolymer, a multiblock copolymer, and mixtures thereof, wherein the blend contains at least one diblock or triblock copolymer. See e.g., col. 2, lines 39-46. However, *DesLauriers* repeatedly teaches and exemplifies only a single combination of two block copolymers - that comprising diblock and triblock copolymers. See e.g., Abstract; col. 2, lines 14-15, 20-24, and 28; col. 3, lines 22-23 and 25-26; col. 4, lines 9, 25-26, and 52-54; col. 6, lines 8, 15-23, and 24-25; col. 7, lines 48-50, 62-63, and 66-68, and Examples 3-8. Thus, *DesLauriers* teaches away from the required selection of block copolymers as one of ordinary skill would be led in a direction divergent from making such a selection.

### **CONCLUSION**

In view of the foregoing remarks, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims.

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If there is any fee due in connection with the filing of this Preliminary  
Amendment, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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